

REMARKS

Claims 1-16 are pending in the application.

Claims 1-16 stand rejected under 35 USC 103(a) as being unpatentable over Bloebaum (USPN 6,188,351). Applicant respectfully traverses this rejection.

To establish a *prima facie* case of obviousness, the cited references must teach or suggest all the claim limitations. (MPEP 706.02(j).) The Examiner recognizes that Bloebaum does not teach that the system determines the code-phase search range and transmits it to the mobile station. Thus, a *prima facie* case of obviousness is not established for the claim.

Accordingly, the rejection of the claims under 35 USC103(a) should be withdrawn in the next Office action. If this rejection is maintained in the next Office action, Applicant respectfully requests a pinpoint cite to the column and line number of the reference for the teaching.

Moreover, in rejecting claim 1-16, the Examiner alleges that it would be obvious to one skilled in the art to combine the teachings of the cited references because it would logically be better to perform complex calculations in the system rather than the mobile station. To properly combine teachings of different references, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of the invention, to combine the teachings to obtain the claimed subject matter. (MPEP 706.02(j).) Conclusory statements made by an examiner regarding the selection and combination of the teachings of the references do not adequately address the issue of motivation to combine. In re Sang Su Lee, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicant submits that the teaching, as well as the suggestion or motivation for combining, is not contained in Bloebaum or in the knowledge generally available to one of ordinary skill in the art at the time of the invention. Rather, the Examiner is engaging in speculation and assumption as to a possible suggestion or motivation to combine the teachings. Thus, a *prima facie* case of

obviousness is not established for the claim.

Accordingly, the rejection of the claims under 35 USC103(a) should be withdrawn in the next Office action on this basis.

In view of the foregoing, Applicant submits that all pending claims are in condition for allowance. Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

If there are any other fees due in connection with the filing of the response, please charge the fees to our Deposit Account No. 17-0026. If a fee is required for an extension of time under 37 CFR 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: 8/12/04

Respectfully submitted,

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